

ADMINISTRATIVE PANEL DECISION

Instagram, LLC v. Brian Breiter, Law Offices of Brian Breiter
Case No. D2022-2149

1. The Parties

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

Respondent is Brian Breiter, Law Offices of Brian Breiter,¹ United States, represented by Holley & Menker, P.A., United States.

2. The Domain Names and Registrar

The disputed domain names <instagramattorneys.com> and <instagramlawyers.com> (the “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 13, 2022. On June 14, 2022, the Center transmitted by email to the Registrar a request for registrar verification in connection with the Domain Names. On June 15, 2022, the Registrar transmitted by email to the Center its verification response disclosing registrant and contact information for the Domain Names, which differed from the named Respondent and contact information in the Complaint. The Center sent an email communication to Complainant on June 16, 2022, providing the registrant and contact information disclosed by the Registrar, and inviting Complainant to submit an amendment to the Complaint. 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”).

¹ At the time of filing the Complaint, the relevant Whois information showed a privacy or proxy service, “Registration Private, Domains By Proxy, LLC”; Complainant filed an amendment to the Complaint to add the Registrar confirmed underlying registrant, “Brian Breiter, Law Offices of Brian Breiter”. In the present circumstances, the Panel considers the Registrar-confirmed underlying registrant details of the Domain Names to constitute the concerned Respondent at issue.

In accordance with the Rules, paragraphs 2 and 4, the Center formally notified Respondent of the Complaint, and the proceedings commenced on June 21, 2022. In accordance with the Rules, paragraph 5, the due date for Response was July 11, 2022. The Response was filed with the Center on July 11, 2022.

The Center appointed Christopher S. Gibson as the sole panelist in this matter on July 19, 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 is a world-renowned online photo and video-sharing social networking application. Since its launch in 2010, Complainant has acquired and developed considerable goodwill and renown worldwide. Acquired by Meta Platforms, Inc. (formerly known as Facebook, Inc.) in 2012, Complainant today has more than 1 billion monthly active accounts worldwide.

Complainant's website, available at "www.instagram.com", was ranked the fifth most visited website in the world according to web information company Alexa. Instagram has consistently been among the top "apps" for mobile devices, including for iOS and Android operating systems. Instagram has been the recipient of numerous awards, including "App of the Year" in 2011 from Apple Inc. Instagram is currently the third most downloaded app for iOS phones worldwide, according to applications information company Data.ai (formerly App Annie). Complainant's growth and popularity has been widely reported by specialized technology publications including Tech Crunch and Mashable.com, as well as mainstream media, including major international publications, such as the New York Times, The Washington Post (United States), The Telegraph, and The Guardian (United Kingdom).

Complainant is the registrant of numerous domain names consisting of or including the INSTAGRAM trademark under a wide range of generic Top-Level Domains ("gTLDs"), as well as under numerous country code Top-Level Domains ("ccTLDs"). Complainant has also made substantial investments to develop a strong presence online by being active on various social media platforms, including Facebook, Twitter, and LinkedIn. For instance, Instagram's official Facebook page has over 59 million "likes" and over 34 million followers on Twitter. These pages are available at the following websites:

- "www.instagram.com/instagram";
- "www.facebook.com/instagram";
- "www.twitter.com/instagram"; and
- "www.linkedin.com/company/instagram".

In addition to its strong presence online, Complainant owns numerous trademark registrations for its INSTAGRAM mark in many jurisdictions around the world, including the following:

- United States Registration No. 4,146,057, INSTAGRAM, registered on May 22, 2012;
- European Union Trade Mark No. 14493886, INSTAGRAM, registered on December 24, 2015; and
- International Registration No. 1129314, INSTAGRAM, registered on March 15, 2012.

Respondent is an attorney licensed to practice in California and Florida, representing individuals who have been injured in different contexts. The Domain Names were registered on June 18, 2021 (<instagramlawyers.com>) and October 19, 2021 (<instagramattorneys.com>). At the time of filing the Complaint, the Domain Name <instagramattorneys.com> redirected to Respondent's official website at

“www.brianbreiter.com”, while the Domain Name <instagramlawyers.com> redirected to Respondent’s official Instagram account at “www.instagram.com/lawbreiter/”.

As of December 2021, the Domain Names were registered in the name of Brian Breiter, Law Offices of Brian Breiter. After Complainant’s request to Respondent to transfer the Domain Names, they were moved under privacy, with the registrant listed as Registration Private, Domains by Proxy, LLC, although their use remained the same. Complainant’s references to Respondent therefore include the Law Offices of Brian Breiter.

A search of Respondent’s registrant details by Complainant revealed that Respondent was associated with several other domain names comprising well-known third-party trademarks, such as <tiktoclawyers.com>, <tiktoklawfirm.com>, <tiktoklegal.com>, and <twitterlawyers.com>. These Domain Names were previously held in the name of Respondent, but were moved under privacy after Complainant’s correspondence with Respondent’s lawyers. However, they are still pointing to Respondent’s website.

On October 22, 2021, Complainant sent a request to the Registrar of the Domain Name <instagramattorneys.com>, asking that it be suspended. Respondent answered providing Respondent’s lawyer’s contact details. On January 11, 2022, Complainant’s lawyers, in an attempt to resolve the matter amicably, sent an email to Respondent’s lawyer requesting the Domain Names to be transferred to Complainant. On January 12, 2022, Respondent’s lawyer replied stating he would review the matter and provide an answer. On February 2, 2022, Complainant’s lawyers sent an email to Respondent’s lawyer restating their previous request. Respondent’s lawyer replied on February 7, 2022, refusing to transfer the Domain Names, claiming that they could not lead to consumer confusion and that their use constituted fair use, as Respondent was merely using Complainant’s trademark to describe Respondent’s services, which included representing individuals or businesses injured as a result of activities occurring on the Instagram platform. On February 25, 2022, Complainant’s lawyers replied explaining that Respondent was unjustly benefitting from Complainant’s goodwill and reputation. Complainant’s lawyers restated their transfer request on April 4, 2022, but no response was received.

5. Parties’ Contentions

A. Complainant

(i) Identical or confusingly similar

As noted in section 4 above, Complainant owns numerous trademark registrations for INSTAGRAM mark in jurisdictions around the world and has used its mark widely around the world. Complainant states it has therefore established trademark rights in the INSTAGRAM mark for the purposes of paragraph 4(a)(i) of the Policy. Given the online nature of Complainant’s business, Complainant emphasizes that its domain names consisting of its INSTAGRAM trademark are not only the heart of its business but also a primary way for millions of users to avail themselves of its services.

Complainant states the Domain Names incorporate the INSTAGRAM trademark in its entirety, with the addition of the descriptive words, “attorneys” and “lawyers”, under the gTLD “.com”. Complainant submits that the incorporation of Complainant’s INSTAGRAM trademark in its entirety in each of the Domain Names is sufficient to establish confusing similarity between the Domain Names and Complainant’s trademarks. The Domain Names differ from Complainant’s INSTAGRAM mark only by the addition of the descriptive words, “attorneys” and “lawyers”. Complainant submits that such minor alterations do not prevent a finding of confusing similarity between the Domain Names and its mark, which remains clearly recognizable in each of the Domain Names.

For reasons set out above, Complainant submits that the Domain Names are confusingly similar to trademarks in which Complainant has rights, in accordance with paragraph 4(a)(i) of the Policy.

(ii) Rights or legitimate interests

Complainant submits that Respondent has no rights or legitimate interests in the Domain Names. Complainant asserts that Respondent is unable to invoke any of the circumstances set out in paragraph 4(c) of the Policy that might demonstrate his rights or legitimate interests in the Domain Names.

Respondent is not using the Domain Names in connection with any *bona fide* offering of goods or services. Respondent is not a licensee of Complainant, nor has Respondent been otherwise authorized by Complainant to make any use of Complainant's INSTAGRAM trademark in a domain name or otherwise. Complainant contends that Respondent cannot assert that prior to any notice of this dispute it was using, or had made demonstrable preparations to use, the Domain Names in connection with a *bona fide* offering of goods or services, in accordance with paragraph 4(c)(i) of the Policy. The Domain Names are being used to promote Respondent's services by redirecting to its main website and to its official Instagram account.

Complainant acknowledges that prior UDRP panels have held that unauthorized service providers using a domain name containing a third-party trademark to provide services in relation to the trademarked goods or services may be making a *bona fide* offering of goods or services and thus have a legitimate interest in such domain name. However, whether this is the case is typically measured against the so-called *Oki Data* criteria:

- 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.

See WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)"), section 2.8; see also *Oki Data Americas, Inc. v. ASD, Inc.*, WIPO Case No. [D2001-0903](#).

Complainant submits that Respondent fails to fulfil the *Oki Data* criteria, specifically:

- i. Respondent is not a *bona fide* service provider in that it is not providing services for the proper use of Complainant's product. Rather, Respondent is making unauthorized use of Complainant's trademarks in order to market its own ancillary services.
- ii. Respondent is not providing services only in relation to the INSTAGRAM trademark. Respondent asserted that Respondent was using the Domain Names in order to promote its services which purportedly include among others, representing individuals or businesses injured as a result of activities that occur on the Instagram platform. However, there is no information on the sites associated with the Domain Names suggesting that Respondent may be providing legal assistance with personal injury cases that would involve the use of Instagram. Rather, Respondent presents itself as a law firm dealing with a broad range of personal injury cases.
- iii. Respondent's website does not accurately and prominently disclose its lack of relationship with Complainant.

In any event, Complainant contends that prior UDRP panels in similar circumstances have held that there is no *bona fide* offering of goods or services where a respondent is using a domain name that is confusingly similar to a complainant's trademark to promote its own commercial activities. In light of the confusing similarity between the Domain Names and Complainant's INSTAGRAM trademark, Complainant submits that Respondent's current use of the Domain Names does not give rise to rights or legitimate interests pursuant to paragraph 4(c)(i) of the Policy.

Complainant further asserts that Respondent cannot legitimately claim to be commonly known by the Domain Names, or a name corresponding to the Domain Names, within the meaning of paragraph 4(c)(ii) of the Policy. According to the publicly-available Whois records, the Domain Names have been registered using a privacy service. Neither of them is being used in the promotion of any business or other online service that might give rise to Respondent being commonly known by the Domain Names. To the best of Complainant's knowledge, there is no evidence of Respondent having acquired or applied for any trademark registrations for "instagram" or any variation thereof, as reflected in the Domain Names. Given the renown of Complainant's trademark, Respondent's use of the Domain Names does not support any reasonable claim of being commonly known by the Domain Names and cannot give rise to any reputation in the Domain Names themselves, independent of Complainant's trademark rights.

Complainant also claims that Respondent is not currently making a legitimate noncommercial or fair use of the Domain Names, without intent for commercial gain to misleadingly divert consumers within the meaning of paragraph 4(c)(iii) of the Policy. As described above, the Domain Names resolve to websites promoting Respondent's services as a law firm representing clients in personal injury litigation, which is clearly commercial in nature and from which Respondent is undoubtedly obtaining financial gain. Such use of the Domain Names by Respondent cannot be considered either legitimate noncommercial or fair, as Respondent is clearly seeking to unfairly exploit the goodwill of Complainant's trademarks for its own profit.

For the foregoing reasons, Complainant submits that it has established a *prima facie* showing that Respondent lacks rights or legitimate interests in the Domain Names. Accordingly, the burden of production shifts to Respondent to come forward with evidence to rebut Complainant's case. In the absence of such evidence, Complainant may be deemed to have satisfied the requirements of paragraph 4(a)(ii) of the Policy.

(iii) Registered and used in bad faith

Complainant asserts that Respondent registered the Domain Names in bad faith. Complainant's states that its INSTAGRAM trademark is inherently distinctive, exclusively associated with Complainant, and well-known throughout the world in connection with its online photo-sharing social network. All search results obtained by typing the term "instagram" into Google's search engine refer to Complainant. Furthermore, Complainant's mark was continuously and extensively used well before the Domain Names were registered in 2021, and has rapidly acquired considerable reputation and goodwill worldwide.

Complainant states that the fame of its trademark is also evidenced by the number of cybersquatters who have sought to exploit the very significant consumer recognition and goodwill attached to its mark. Complainant has referenced prior UDRP cases in which panels have recognized the strength and renown of Complainant's INSTAGRAM trademark, and have ordered the transfer of disputed domain names to Complainant.

In light of the above, Complainant submits that Respondent could not credibly argue that it did not have knowledge of Complainant or its INSTAGRAM trademark when registering the Domain Names in October and June 2021, by which time Instagram had amassed over 2 billion monthly active users. In fact, Respondent's lawyer acknowledged its awareness of Complainant's trademark in his email to Complainant's lawyers arguing that the Domain Names were registered to promote Respondent's services representing clients injured as a result of activities on Instagram. Complainant submits that Respondent specifically targeted Complainant's trademark to unjustly benefit from its goodwill and reputation.

In addition, Complainant asserts that Respondent also appears to be the registrant of several domain names comprising well-known third-party trademarks. Complainant therefore submits that Respondent has engaged in a pattern of registering domain names comprising third-party trademarks, targeting well-known trademark owners, and thus registered the Domain Names in order to prevent Complainant from reflecting its trademark in corresponding domain names, in bad faith as contemplated by paragraph 4(b)(ii) of the Policy.

Finally, in view of the surrounding circumstances, Complainant claims that Respondent's use of a privacy service to conceal its identity, after Complainant's request for a transfer of the Domain Names, further

supports an inference of bad faith on the part of Respondent. For the foregoing reasons, Complainant submits that the Domain Names were registered in bad faith.

Complainant also contends that the Domain Names have been used in bad faith. Complainant states the Domain Names are used by Respondent to promote Respondent's services as a personal injury law firm, and such use is clearly in bad faith as Respondent is using Complainant's trademark seeking to increase traffic to its website in order to obtain commercial gain derived from the goodwill and reputation attached to Complainant's trademark. Complainant submits that by using the Domain Name in this manner, Respondent has intentionally attempted to 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 or location to which the Domain Names resolve, in bad faith pursuant to paragraph 4(b)(iv) of the Policy. Complainant further asserts that prior UDRP panels have found use in bad faith in similar circumstances.

In view of the above, Complainant asserts that the Domain Names were registered and are being used in bad faith, in accordance with paragraph 4(a)(iii) of the Policy.

B. Respondent

(i) Identical or confusingly similar

Respondent contends that the Domain Names are not identical or confusingly similar to a trademark or service mark in which Complainant has rights. First, Respondent states the Domain Names are not identical to any trademark or service mark in which Complainant has rights. Complainant does not allege that they are. Further, Respondent contends the Domain Names are not confusingly similar to any trademark or service mark in which Complainant has rights. As an initial matter, Respondent does not contest Complainant's ownership of trademark rights in the term INSTAGRAM or the registrations and applications therefor. However, Complainant does not own any trademark rights for "instagramattorneys" or "instagramlawyers". Respondent contends that when compared in their entireties, both "instagramattorneys" and "instagramlawyers" are readily distinguishable from the INSTAGRAM mark in sound, appearance, and meaning. There is no question that users can distinguish between <instagram.com> and the much longer <instagramattorneys.com> and <instagramlawyers.com>.

While Complainant argues that the obvious differences between INSTAGRAM, on the one hand, and "instagramattorneys" and "instagramlawyers", on the other hand, can be disregarded because the terms "attorneys" and "lawyers" are descriptive, Respondent emphasizes that these terms are descriptive only of the services that Respondent offers. They are not descriptive of any product or service that Complainant offers. This distinction goes to the heart of the dispute in this case.

(ii) Rights or legitimate interests

Respondent states that it has legitimate interests in respect of the Domain Names. They are being used to promote Respondent's legitimate legal services by currently redirecting Internet traffic to Respondent's main social media profile at "www.instagram.com/lawbreiter/" and to Respondent's main website at "www.brianbreiter.com".

Respondent states he is a well-respected attorney licensed to practice in California and Florida. Respondent represents individuals who have been injured in a variety of contexts. For example, Respondent represents individuals that have been injured as the result of water related accidents. In connection with this area of practice, Respondent owns the domain names <lifeguardlawyers.com>, <lifeguardattorney.com>, and <lifeguardlitigators.com>. (The Panel notes that these all direct to Registrar parking pages, and to state the obvious: they begin with a dictionary term (plus a legal industry term), as opposed to a famous third-party brand name.) Similarly, Respondent promotes his ability to represent individuals injured in a context that involves the Instagram platform. To this end, Respondent often uses the hashtag "#lawyersofinstagram" and has used this hashtag in posts since at least as early as October 2021 when the Domain Names were first

registered.

Respondent highlights that Complainant concedes that “[p]rior UDRP panels have held that unauthorized service providers using a domain name containing a third-party trade mark to provide services in relation to the trade marked goods or services may be making a *bona fide* offering of goods or services and thus have a legitimate interest in such domain name.”

Respondent asserts that whether the use of a third-party trademark constitutes nominative fair use, including nominative fair use of others’ trademarks by incorporating them into domain names, is a well-established doctrine in trademark jurisprudence. It accepts that there may be lawful non-consensual use of another’s trademark in the context of non-infringing products or services. Respondent claims he is not using more of the INSTAGRAM mark than is necessary to inform potential clients that it represents individuals injured through and/or by the Instagram platform. Respondent has never falsely suggested Respondent was sponsored or endorsed by the trademark holder, nor is it likely that individuals will be misled to divert any of Complainant’s users.

Respondent states he is offering legal services to those injured by Instagram or through the Instagram platform. Lawsuits against social media platforms, including Instagram, are growing in the United States and elsewhere. Thus, Respondent is using the Instagram trademark to describe Respondent’s legal services. Respondent is not attempting to divert Complainant’s users to its website, which offers no social media functionality. Respondent is not tarnishing Complainant’s mark. Respondent is using the INSTAGRAM mark in such a way that the origin of the services remains clear. There is no competition between Complainant and Respondent. Respondent is doing nothing to reduce the distinctiveness of Complainant’s INSTAGRAM mark.

Lastly, Respondent contends he has not cornered the market on INSTAGRAM domain names, thus depriving Complainant from reflecting its own mark in a domain name. Complainant has no use for terms such as “attorneys” or “lawyers” to describe its business. Moreover, there are currently an unlimited number of domain name possibilities in the modern domain name era, where there are hundreds of new gTLDs and ccTLDs.

(iii) Registered and used in bad faith

Respondent argues that Complainant’s arguments are flawed – that Complainant contends the Domain Names were registered in bad faith because “[t]he Respondent has no reason to use the domain names other than to attract Internet users by suggesting that the Complainant is associated with the Respondent or has endorsed the Respondent’s products. This is an attempt to misappropriate the Complainant’s reputation for commercial gain.” Respondent responds that Complainant has provided no evidence or explanation for this argument. There is nothing to suggest that Respondent is attempting to imply that Respondent is associated with Complainant or that Complainant has endorsed Respondent’s services. Respondent states that it is the opposite, that no reasonable person would believe that Respondent has been authorized or endorsed by Complainant to bring lawsuits against Complainant. There would be a conflict of interest in such a theoretical relationship that would make the practice entirely implausible. No reasonable person would even contemplate using an attorney that their adversary is recommending to them.

Thus, Respondent argues that Complainant has failed to show that Respondent has registered or is using the Domain Names in bad faith.

6. Discussion and Findings

In order to succeed on its Complaint, Complainant must demonstrate that the three elements set forth in paragraph 4(a) of the Policy have been satisfied. These elements are that:

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

A. Identical or Confusingly Similar

The Panel determines that Complainant has demonstrated it has strong and well-established rights in its distinctive INSTAGRAM trademark, through both extensive registration and widespread use. See *Instagram, LLC v. Bozulma Artik, hayat*, WIPO Case No. [D2021-4121](#).

The Panel further finds that the Domain Names are confusingly similar to Complainant's INSTAGRAM mark. Each of the Domain Names incorporate the distinctive INSTAGRAM mark in its entirety, with the placement of the mark in each case in the dominant position at the beginning of the relevant Domain Name, followed by the terms "attorneys" or "lawyers", as the case may be. The addition of these terms does not prevent a finding of confusing similarity in this case. Numerous decisions make UDRP jurisprudence clear on this point – that the addition of other terms (whether descriptive, geographical, pejorative, meaningless, or otherwise) does not prevent a finding of confusing similarity. See [WIPO Overview 3.0](#), section 1.7 ("where at least a dominant feature of the relevant mark is recognizable in the domain name, the domain name will normally be considered confusingly similar to that mark for purposes of UDRP standing."); see also *WhatsApp Inc. v. Moose Scheib*, WIPO Case No. [D2019-0541](#) (<whatsappalawyer.com>, <whatsappforlegal.com>, <whatsapplaw.com>, <whatsapplawyer.com>, <whatsapplegal.com>, and <whatsapp4legal.com>).

Accordingly, the Panel finds that the Domain Names are confusingly similar to a trademark in which Complainant has rights in accordance with paragraph 4(a)(i) of the Policy.

B. Rights or Legitimate Interests

Under paragraph 4(a)(ii) of the Policy, Complainant bears the burden of establishing that Respondent lacks rights or legitimate interests in the Domain Names. However, once Complainant makes a *prima facie* showing under paragraph 4(a)(ii) of the Policy, the burden of production shifts to Respondent to establish rights or legitimate interests in the Domain Names by demonstrating any of the following, without limitation, under paragraph 4(c) of the Policy:

- (i) before any notice of the dispute, Respondent's use of, or demonstrable preparations to use, the Domain Names or a name corresponding to the Domain Names in connection with a *bona fide* offering of goods or services; or
- (ii) Respondent has been commonly known by the Domain Names, even if Respondent has acquired no trademark or service mark rights; or
- (iii) Respondent is making a legitimate noncommercial or fair use of the Domain Names, without intent for commercial gain to misleadingly divert consumers or to tarnish the trademark or service mark at issue.

Here, the Panel finds that Complainant has made a *prima facie* showing that Respondent lacks rights or legitimate interests in the Domain Names, thus shifting the burden to Respondent. The Panel further determines that Respondent has not successfully rebutted Complainant's *prima facie* case.

First, there are several submissions by Complainant that Respondent does not challenge:

- (i) that Complainant has not authorized Respondent to use Complainant's well-known INSTAGRAM trademark for any purpose including in domain names – Respondent does not contest this point;

(ii) that Respondent is not commonly known by the Domain Names – Respondent does not contest this point and the evidence indicates Respondent is known as “Brian Breiter” or “Law Offices of Brian Breiter”, while the Domain Names are used only to redirect to Respondent’s official website at “www.brianbreiter.com” and to Respondent’s Instagram site at “www.instagram.com/lawbreiter/”; and

(iii) that Respondent has not used the Domain Names for a legitimate noncommercial use – instead, the Domain Names are used to redirect to Respondent’s primary online locations – Respondent’s law firm website and Instagram account – in support of Respondent’s law practice representing clients in personal injury litigation, which is commercial in nature and from which Respondent obtains financial gain.

With regard to the contested points between the parties, Complainant contends that Respondent has not used the Domain Names in connection with a *bona fide* offering of goods or services, in accordance with paragraph 4(c)(i) of the Policy, so as to demonstrate any rights or legitimate interests in them. Further, Complainant claims that Respondent is not making a legitimate fair use of the Domain Names, without intent for commercial gain to misleadingly divert consumers within the meaning of paragraph 4(c)(iii) of the Policy. As to these points, Complainant contends that Respondent, by registering the confusingly similar Domain Names, is seeking to unfairly exploit the fame and goodwill of Complainant’s INSTAGRAM trademark for Respondent’s own profit by using the Domain Names to redirect to Respondent’s separate website and Instagram account, thereby promoting Respondent’s commercial law firm services.

The crux of Respondent’s response is that Respondent has legitimate interests in respect of the Domain Names because they are being used in a manner that constitutes nominative fair use to promote Respondent’s legal services, by redirecting Internet traffic to Respondent’s primary website at “www.brianbreiter.com” and to Respondent’s social media profile on Instagram. Respondent asserts that he is not using more of the INSTAGRAM mark than is necessary to inform potential clients that it represents (or would represent) individuals injured via the Instagram platform and he has never suggested that Respondent is sponsored or endorsed by Complainant. Respondent claims he is using the INSTAGRAM mark in a manner such that the origin of the services remains clear.

Complainant has referred to the *Okidata* test to argue that Respondent’s use of the Domain Names is not *bona fide* or fair and does not give rise to any rights or legitimate interests: (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. See [WIPO Overview 3.0](#), section 2.8; see also *Okidata Americas, Inc. v. ASD, Inc.*, WIPO Case No. [D2001-0903](#). The *Okidata* criteria are normally applied in UDRP cases where a reseller, distributor, or service provider is using a domain name containing the complainant’s trademark to undertake sales, re-sales, or repairs related to the complainant’s goods or services. However, as observed by the panel in *201 Folsom Option JV, L.P. and 201 Folsom Acquisition, L.P. v. John Kirkpatrick*, WIPO Case No. [D2014-1359](#):

“The *Okidata* approach considers and applies nominative fair use principles not in the broader context of traditional trademark disputes, but with reference to the limited scope of the Policy, and specifically with respect to the respondent’s use of the complainant’s mark in a domain name. While the instant case does not involve a reseller or distributor of a manufacturer’s trademarked products, several panels have concluded that consideration of the *Okidata* criteria may be appropriate under the Policy in other contexts.”

Moreover, “[a]n overarching principle of the *Okidata* approach is that a use of a domain name cannot be ‘fair’ if it suggests affiliation with the trademark owner; nor can a use be ‘fair’ if it is pretextual.” *The Royal Edinburgh Military Tattoo Limited v. Identity Protection Service, Identity Protect Limited / Martin Clegg, WM Holdings*, WIPO Case No. [D2016-2290](#).

Here, Respondent is using Complainant’s well-known INSTAGRAM trademark in the Domain Names, not solely to provide services in relation to Complainant’s Instagram offerings, but instead to promote its own unrelated services focusing on a general personal injury law practice. It bears noting, in this regard, that

Respondent's law practice does not focus exclusively on alleged injuries arising from use of Complainant's Instagram offerings – in fact, Respondent has not indicated that he has handled a single case related to Complainant and Respondent's website does not mention cases involving Complainant. Nor do the Disputed Domain Names direct to a specific site dedicated solely to Instagram-related lawsuits (it also bears noting that Respondent has not provided any disclaimer on his website), but rather to Respondent's general law practice site.

The Policy, paragraph 4(c)(iii), provides that a respondent may demonstrate rights or legitimate interests in a domain name by providing evidence of "legitimate noncommercial or fair use of the domain name, without intent for commercial gain to misleadingly divert consumers or to tarnish the [complainant's] trademark or service mark." As noted above, Respondent's use is not noncommercial. However, as provided by [WIPO Overview 3.0](#), section 2.5.3, "specific case factors have led panels to find that fair use need not always be categorically noncommercial in nature". At the same time, however, if the use of a trademark is "for commercial gain to misleadingly divert consumers", then that use may not be considered "fair".

After careful consideration of the totality of circumstances in the record in this case, the Panel is of the view that Respondent is making a less than a fair or *bona fide* use of the Domain Names under the Policy. The Domain Names adopted by Respondent do not in the Panel's opinion accurately convey the purpose to which they are put – again, to redirect to Respondent's general law practice website. The Panel determines that Complainant's INSTAGRAM trademark qualifies as a famous or widely-known trademark, as Complainant has more than one billion active user accounts around the world. Further, the placement of Complainant's distinctive and well-known mark INSTAGRAM in the dominant position at the beginning of each Domain Name, followed by the terms, "attorneys" or "lawyers", is likely to generate confusion. The Panel therefore disagrees with Respondent's submission that the "origin of the services" under the Domain Names is clear, as Internet visitors using the Domain Names are redirected to Respondent's law firm website at "www.brianbreiter.com" or to Respondent's Instagram site at "www.instagram.com/lawbreiter/", without any further explanation by Respondent to dispel potential confusion or explain the non-relationship to Complainant.

Therefore, in balancing the rights of Complainant in its well-known INSTAGRAM mark, and the right of Respondent to choose freely a domain name, the Panel concludes that Respondent has impermissibly taken advantage of Complainant's commercial interests in its well-known INSTAGRAM mark. The Panel does not doubt that Respondent operates an active personal injury law firm. However, the Panel is persuaded by the analysis in *Facebook Inc. v. Stuart West, West & Associates, A PC*, WIPO Case No. [D2015-1766](#) concerning a similarly famous and well-known trademark, FACEBOOK, and the sphere of exclusivity provided by such a mark:

"Given the exclusive trademark rights that reside in the Complainant and the extensive global reputation now inherent in its marks, the Respondent could not legitimately acquire any public association between himself and the Complainant's mark FACEBOOK or even any mark similar thereto, certainly for the services provided by the Complainant under its marks. This is so in light of the Complainant's exclusive trademark rights which date back to 2006 in connection with the mark FACEBOOK and the extensive global reputation and recognition which its FACEBOOK marks have since acquired – which clearly predate April 13, 2012, when the Respondent registered the disputed domain name. [...] Further, given the fame now inherent in the mark FACEBOOK, the sphere of exclusivity provided by that mark extends, well beyond the services specifically set forth in the Complainant's registrations, to encompass, as a source-indicator, a rather expansive realm of goods and services which Internet users (the market for the Complainant's social networking services) might reasonably think emanate or have some connection, whether by affiliation, sponsorship or endorsement, with the Complainant. Upon seeing the disputed domain name <patentfacebook.com>, it is well within reason for Internet users to believe that the Respondent's patent-related legal services are sponsored or sanctioned by or affiliated or connected with the Complainant in some manner — when, in fact, they are not and no relationship whatsoever exists between these two entities. As such, the Respondent could never likely become commonly known by the disputed domain name or the Complainant's marks for a wide range of goods and services, probably including the Respondent's own legal services, without infringing on the exclusive trademark rights of the Complainant."

Accordingly, for all of the above reasons, the Panel finds that Complainant has made a *prima facie* showing of Respondent's lack of rights or legitimate interests in respect of the Domain Name, which has not been sufficiently rebutted by Respondent. The Panel therefore finds that Complainant has established the second element of the Policy in accordance with paragraph 4(a)(ii).

C. Registered and Used in Bad Faith

The third element of paragraph 4(a) of the Policy requires that Complainant demonstrate that Respondent registered and is using the Domain Names in bad faith. [WIPO Overview 3.0](#), section 3.1, states "bad faith under the UDRP is broadly understood to occur where a respondent takes unfair advantage of or otherwise abuses a complainant's mark". Paragraph 4(b) of the Policy indicates that certain circumstances may, "in particular but without limitation", be evidence of the registration and use of a domain name in bad faith. These include that "(iv) 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] web site or location."

Moreover, [WIPO Overview 3.0](#), section 3.1.4, states in relevant part that "Panels have consistently found that the mere registration of a domain name that is identical or confusingly similar (particularly domain names comprising typos or incorporating the mark plus a descriptive term) to a famous or widely-known trademark by an unaffiliated entity can by itself create a presumption of bad faith", and that, among the "evidence to support a finding that a respondent has registered a domain name to attract, for commercial gain, Internet users to its website by creating a likelihood of confusion with the complainant's mark" is "redirecting the domain name to a different respondent-owned website".

For the reasons discussed under this and the preceding heading, the Panel considers that Respondent's conduct in this case constitutes bad faith registration and use of the Domain Names within the meaning of paragraph 4(a)(iii) of the Policy. It is evident that Respondent was aware of Complainant and its INSTAGRAM trademark, and targeted that mark, when registering the Domain Names. In this case, where Complainant's INSTAGRAM trademark is so strong and distinctive, including in the United States where Respondent is located, it is a reasonable inference in the circumstances of this case that Respondent registered the Domain Names based on the goodwill and reputation of Complainant's mark, in order to drive traffic by redirecting to Respondent's own website and online Instagram location, where Respondent offers its unrelated general personal injury legal services. In the attendant circumstances of this case, the Panel considers it more likely than not that the Respondent's primary motive in relation to the registration and use of the Domain Names was to capitalize on, or otherwise take advantage of, Complainant's well-known trademark rights, for commercial gain. This amounts to bad faith use within the broad ambit of the Policy. See [WIPO Overview 3.0](#), section 3.1.4.

In conclusion, the Panel determines that, for all of the above reasons, the Domain Names were registered and are being used in bad faith. Accordingly, Complainant has satisfied the third element 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 Domain Names, <instagramattorneys.com> and <instagramlawyers.com>, be transferred to Complainant.

/Christopher S. Gibson/

Christopher S. Gibson

Sole Panelist

Date: August 24, 2022