

## **ADMINISTRATIVE PANEL DECISION**

Instagram, LLC v. sanjana rao  
Case No. D2023-1745

### **1. The Parties**

The Complainant is Instagram, LLC, United States of America, represented by Tucker Ellis, LLP, United States of America ("United States").

The Respondent is sanjana rao, India.

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

The disputed domain name <orginstagram.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 April 20, 2023. On April 20, 2023, the Center transmitted by email to the Registrar a request for registrar verification in connection with the Disputed Domain Name. Still 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 (REGISTRATION PRIVATE / DOMAINS BY PROXY, LLC.) and contact information in the Complaint. The Center sent an email communication to the Complainant on April 25, 2023, providing the registrant and contact information disclosed by the Registrar, and inviting the Complainant to submit an amendment to the Complaint. The Complainant filed an amended Complaint on April 27, 2023.

The Center verified that the Complaint, together with the amended Complaint, satisfied the formal requirements of the Uniform Domain Name Dispute Resolution Policy (the "Policy" or "UDRP"), the Rules for Uniform Domain Name Dispute Resolution Policy (the "Rules"), and the WIPO Supplemental Rules for Uniform Domain Name Dispute Resolution Policy (the "Supplemental Rules").

In accordance with the Rules, paragraphs 2 and 4, the Center formally notified the Respondent of the Complaint, and the proceedings commenced on April 28, 2023. In accordance with the Rules, paragraph 5, the due date for Response was May 18, 2023. The Respondent did not submit any response. Accordingly, the Center notified the Respondent's default on May 23, 2023.

The Center appointed Flip Jan Claude Petillion as the sole panelist in this matter on June 9, 2023. 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, Instagram LLC, operates a social networking service and mobile application under the name INSTAGRAM, which has over 1 billion monthly active users worldwide.

The Complainant is the holder of trade and service mark registrations across various jurisdictions throughout the world for INSTAGRAM, which it uses in connection with its social networking service and mobile application. The Complainant's trademark portfolio includes, *inter alia*, the following trade and service mark registrations:

- INSTAGRAM, United States word mark registered with the USPTO on May 22, 2012, under number 4,146,057 in class 9;
- INSTAGRAM, International word mark registered with WIPO on March 15, 2012, under number 1129314 in classes 9 and 42;
- INSTAGRAM, Indian word mark registered with Intellectual Property India on December 19, 2013, under number 2645896 in class 9.

The Disputed Domain Name has been registered on December 14, 2021. According to evidence provided by the Complainant, the Disputed Domain Name used to resolve to a website offering a service purporting to allow users to download content from the Complainant's social media platform. The Disputed Domain Name currently resolves to an inactive "Index of/" page.

#### **5. Parties' Contentions**

##### **A. Complainant**

In summary, the Complainant considers the Disputed Domain Name to be confusingly similar to trademarks in which it claims to have rights.

The Complainant further claims that the Respondent has no rights or legitimate interests in respect of the Disputed Domain Name. According to the Complainant:

- the Respondent has neither been licensed nor authorized to use the Complainant's INSTAGRAM mark, nor does Respondent have any legal relationship with the Complainant that would entitle the Respondent to use the INSTAGRAM mark;
- the Respondent is not making a *bona fide* offering of goods or services at the Disputed Domain Name, as it provided a service purporting to allow users to download content from the Complainant's social media platform. Moreover, the Disputed Domain Name is on at least one block list for use in relation to spam, malware or other domain name abuse;
- the Respondent is not known by the Disputed Domain Name;
- the Respondent is not making a legitimate noncommercial or fair use of the Disputed Domain Name.

Finally, the Complainant claims that the Disputed Domain Name was registered and is being used in bad faith. In the Complainant's view, the Respondent was undoubtedly aware of the existence of the Complainant's trademark when registering the Disputed Domain Name and intentionally attempted to attract Internet users to its website for commercial gain, by creating a likelihood of confusion with the Complainant's trademark as to the source, sponsorship, affiliation, or endorsement of the Respondent's website linked to the Disputed Domain Name.

## **B. Respondent**

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

## **6. Discussion and Findings**

Paragraph 15(a) of the Rules provides that the Panel is to decide the Complaint on the basis of the statements and documents submitted in accordance with the Policy, the Rules and any rules and principles of law that it deems applicable.

The onus is on the Complainant to make out its case and it is apparent, both from the terms of the Policy and the decisions of past UDRP panels, that the Complainant must show that all three elements set out in paragraph 4(a) of the Policy have been established before any order can be made to transfer the Disputed Domain Name. As the UDRP proceedings are administrative, the standard of proof is the balance of probabilities.

Thus, for the Complainant to succeed it must prove, within the meaning of paragraph 4(a) of the Policy, that:

- (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.

The Panel will therefore deal with each of these requirements.

### **A. Identical or Confusingly Similar**

To prove this element, the Complainant must first establish that there is a trademark or service mark in which it has rights. The Complainant has clearly established that there is a trademark in which it has rights. The Complainant's INSTAGRAM trademark has been registered since more than a decade and used in connection with the Complainant's social networking products and services.

The Panel observes that the Disputed Domain Name incorporates the Complainant's INSTAGRAM mark in its entirety, adding the term "org" in front of it. Where the relevant trademark is recognizable within the disputed domain name, the addition of other terms (whether descriptive, geographical, pejorative, meaningless, or otherwise) would not prevent a finding of confusing similarity under the first element (see section 1.8 of the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)")).

Additionally, it is well established that generic Top-Level Domains ("gTLDs"), here ".com", may be disregarded when considering whether a disputed domain name is confusingly similar to a trademark in which a complainant has rights.

In light of the above, the Panel considers the Disputed Domain Name to be confusingly similar to the Complainant's INSTAGRAM trademark.

## B. Rights or Legitimate Interests

Under paragraph 4(a)(ii) of the Policy, the Complainant has the burden of establishing that the Respondent has no rights or legitimate interests in respect of the Disputed Domain Name.

As established by previous UDRP panels, it is sufficient for the Complainant to make out a *prima facie* showing that the Respondent has no rights or legitimate interests in the Disputed Domain Name in order to place the burden of production on the Respondent (see section 2.1 of the [WIPO Overview 3.0](#)).

The Panel notes that the Respondent has not apparently been commonly known by the Disputed Domain Name and that the Respondent does not seem to have acquired trademark or service mark rights. According to the information provided by the Registrar, the name of the Respondent is “sanjana rao”. The Respondent’s use and registration of the Disputed Domain Name was not authorized by the Complainant. There are no indications that a connection between the Complainant and the Respondent exists or existed.

Where a domain name consists of a trademark plus an additional term, UDRP panels have largely held that such composition cannot constitute fair use if it effectively impersonates or suggests sponsorship or endorsement by the trademark owner (see section 2.5.1 of the [WIPO Overview 3.0](#)). The Disputed Domain Name incorporates the Complainant’s INSTAGRAM mark in its entirety and simply adds the term “org” in front of it. The Panel finds that this term can easily be considered as the abbreviation of the descriptive term “organization” and does nothing to prevent the confusion with the Complainant’s mark. Therefore, the Panel finds that the Disputed Domain Name carries a risk of implied affiliation with the Complainant.

Beyond looking at the domain name and the nature of any additional terms appended to it, UDRP panels assess whether the overall facts and circumstances of the case, such as the content of the website linked to the disputed domain name and the absence of a response, support a fair use or not (see sections 2.5.2 and 2.5.3 of the [WIPO Overview 3.0](#)).

Based on the evidence provided by the Complainant, the Panel observes that the Disputed Domain Name referred to a website offering services purporting to allow users to download content from the Complainant’s social media platform. In the Panel’s view and as confirmed by previous UDRP panels, this neither amounts to a *bona fide* offering of goods or services nor a legitimate noncommercial or fair use of the Disputed Domain Name (see *Instagram, LLC v. Contact Privacy Inc. Customer 0152196674 / Stefano Scerra*, WIPO Case No. [D2021-1883](#); *Instagram, LLC v. Domains By Proxy, LLC / Ahmed Hemaïd*, WIPO Case No. [D2021-1439](#)).

The Respondent had the opportunity to demonstrate its rights or legitimate interests but did not do so. In the absence of a Response from the Respondent, the *prima facie* case established by the Complainant has not been rebutted.

Therefore, the Panel finds that the Complainant has established that the Respondent has no rights or legitimate interests in the Disputed Domain Name. In light of the above, the Complainant succeeds on the second element of the Policy.

## C. Registered and Used in Bad Faith

The Complainant must prove on the balance of probabilities both that the Disputed Domain Name was registered in bad faith and that it is being used in bad faith (see section 4.2 of the [WIPO Overview 3.0](#) and, for example, *Telstra Corporation Limited v. Nuclear Marshmallows*, WIPO Case No. [D2000-0003](#), and *Control Techniques Limited v. Lektronix Ltd*, WIPO Case No. [D2006-1052](#)).

Paragraph 4(b) of the Policy provides a non-exclusive list of factors, any one of which may demonstrate bad faith. Among these factors demonstrating bad faith registration and use is the use of a domain name to intentionally attempt to attract, for commercial gain, Internet users to a 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 website or location or of a product or service on the website or location.

In the present case, the Panel finds it inconceivable that the Respondent was unaware of the Complainant and its trademark rights when it registered the Disputed Domain Name:

- the Complainant's mark predates the registration of the Disputed Domain Name by almost a decade, including in India where the Respondent appears to be located;
- the Disputed Domain Name incorporates the Complainant's trademark in its entirety with the mere addition of a descriptive abbreviation;
- the website linked to the Disputed Domain Name appeared to offer services which directly referred to the Complainant's social media platform; and
- previous UDRP panels confirmed the well-known character and reputation of the Complainant's mark (see *Instagram, LLC v. Asif Ibrahim, Asif Ibrahim*, WIPO Case No. [D2020-2552](#); *Instagram, LLC v. Fahrettin Turgut and Arif Zihnioglu, Takipcizevki*, WIPO Case No. [D2020-2751](#)).

In the Panel's view, the Respondent's awareness of the Complainant's trademark rights at the time of registration suggests bad faith (see *Red Bull GmbH v. Credit du Léman SA, Jean-Denis Deletraz*, WIPO Case No. [D2011-2209](#); and *BellSouth Intellectual Property Corporation v. Serena, Axel*, WIPO Case No. [D2006-0007](#)).

The Respondent used the Disputed Domain Name to resolve to a website offering services purporting to allow users to download content from the Complainant's social media platform. In the Panel's view, this indicates that the Respondent has intentionally attempted to attract Internet users to its website for (direct or indirect) commercial gain by creating a likelihood of confusion with the Complainant's trademark. Previous UDRP panels found (very) similar uses of a domain name to be indicative of bad faith (see *Instagram, LLC v. Domains By Proxy, LLC / Ahmed Hemaïd*, WIPO Case No. [D2021-1439](#); *Instagram, LLC v. Contact Privacy Inc. Customer 1247361676 / GUELCE JEAN-CLAUDY*, WIPO Case No. [D2021-1675](#)).

Given the totality of the circumstances discussed above, the current state of the Disputed Domain Name referring to an inactive web page does not prevent a finding of bad faith under the doctrine of passive holding (see section 3.3 of the [WIPO Overview 3.0](#)). Given the nature of the Disputed Domain Name, the Panel finds it difficult to conceive of any future good faith use to which the Disputed Domain Name may be put.

By failing to respond to the Complaint, the Respondent did not take any initiative to contest the foregoing. Pursuant to paragraph 14 of the Rules, the Panel may draw the conclusions it considers appropriate.

Therefore, the Panel finds that, on the balance of probabilities, it is established that the Disputed Domain Name was registered and is being used in bad faith. In light of the above, the Complainant also succeeds on the third and last 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 Disputed Domain Name <orginstagram.com> be transferred to the Complainant.

*/Flip Jan Claude Petillion/*

**Flip Jan Claude Petillion**

Sole Panelist

Date: June 23, 2023